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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO. VB
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/486,062

Applicant(s)

Holzemann

Examiner

David Lukton

Group Art Unit

1653



☒ Responsive to communication(s) filed on Oct 5, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) 4 and 8-10 is/are withdrawn from consideration.

☒ Claim(s) 1-3, 5-7, and 11-19 is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Pursuant to the directives of paper No. 7 (filed 10/5/00), claims 1, 3, 6 have been amended, and claims 11-19 added. Claims 1-19 are pending.

*

Applicants' election of Group I with traverse is acknowledged, as is the elected specie (the compound of example 1, pp. 22-23). Applicants have argued that the search for compounds will overlap the search for methods of making and using the compounds. This is not necessarily true; if the compounds are known for many different uses, Group I could be searched completely without necessarily having done a complete search of Group II or III. However, the point will be moot if the compounds turn out to be novel. The restriction is maintained at the present time; the issue will be revisited later.

Claims 1-3, 5-7 and 11-19 are examined in this Office action; claims 4, 8-10 are withdrawn from consideration.

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The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5-7 and 11-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one

skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification asserts (pp. 19-20) that the compounds are useful to treat circulatory disorders, thrombosis, cardiac infarction, coronary heart disease, arteriosclerosis, apoplexy, angina pectoris, cancer, osteoporosis, inflammation, infections, restenosis and rheumatoid arthritis. However, none of the compounds has been shown to be useful in any assay. As it happens, one cannot determine pharmacological activity of a given compound merely by viewing its structure. Most randomly selected compounds are in fact devoid of activity. Even the expenditure of "undue experimentation" is no assurance that any of the compounds will have any particular activity.

In addition to the foregoing, claims 1 and 3 are rejected because of the recitation of "physiologically acceptable" salts; claim 6 is rejected because of its recitation of "pharmaceutical". These terms imply therapeutic efficacy, which is not in evidence. (A step in the direction of overcoming this rejection would be to delete the terms at issue).

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Claim 6 is rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is rejected in part because it is grammatically incorrect (perhaps presence of the term *comprises* was intended). More substantively however, it is not clear what the

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comparison is supposed to be. Is it applicants position that the pharmaceutical composition of claim 6 is superior to all pharmaceutical compositions previously disclosed?

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No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800